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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/157,497 09/21/98 INAMOTO

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EXAMINER

SCHWARTZ, P

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/157497

Applicant(s)

Inamoto et al.

Examiner

Schwartz, P

Group Art Unit

1774

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 123 is/are pending in the application.
- Of the above claim(s) 6 - 123 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1 - 123 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a recording medium, classified in class 428, subclass 195.
 - II. Claims 9-11, drawn to a method of use (image forming process), classified in class 347, subclass 105.
 - III. Claims 12-13, drawn to a method of making, classified in class 427, subclass 375.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a materially different method such as a method of writing with an ink pen.
3. Inventions of Group I and of Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by a materially different process such as a process including mixing pigment particles with thermoplastic resin and applying the mixture to the substrate in a molten state.

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4. Inventions of Group II and of Group III are methods of making and using the same product. Since the product has been shown to be distinct from both method of use and method of making, the methods are also distinct.

5. This application contains claims directed to the following patentably distinct species of the claimed invention: species a) having a polyvinyl chloride resin substrate, b) having a polystyrene substrate, c) having a polycarbonate substrate, and d) having a terephthalic acid-ethylene glycol-cyclohexane dimethanol copolymer substrate.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Ms. Dudek on July 17, 2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8 and the species of claim 5, polyvinyl chloride. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention or species.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "mutually fused thermoplastic particles" is confusing. It is unclear whether the final product actually contains thermoplastic particles or to what degree any particle structure is present in the final product.

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9. Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Document 2-31673 in view of either of Manser et al. or Warther.

The Japanese Document discloses a medium for ink jet recording comprising a base having a layer of pigment particles of large ink absorbent capacity on the surface thereof. While the abstract does not mention the use of alumina hydrate as the pigment, it is well known in this art to use alumina hydrate as an ink absorptive pigment so that such use as the pigment disclosed by the reference would have been obvious to one of ordinary skill in the art. The reference also discloses a surface layer of thermoplastic particles which may be fused by heat or solvent. When the layer is fused, it will inherently fill in gaps within the pigment layer and become part of that layer.

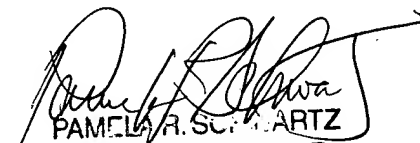
The secondary art teach cards or IDs which may be printed upon and which have bases or cores of metal or plastic films including polyvinyl chloride. See col. 9, line 62 to col. 10, line 27 of Warther and col. 2, lines 30-47 of Manser et al. Based upon the secondary art, it would have been obvious to one of ordinary skill in the art to utilize polyvinyl chloride as the supporting base of the primary reference.

10. Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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The prior art does not teach or suggest the claimed structure including an additional porous outermost layer comprising thermoplastic resin particles on an ink receiving layer of pigment particles and fused thermoplastic particles.

PRSchwartz
July 31, 2000



PAMELA R. SCHWARTZ
PRIMARY EXAMINER